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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Carolyn Pianin

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EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/766,726	<b>Applicant(s)</b> PIANIN, CAROLYN	
	<b>Examiner</b> NARESH VIG	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,11-17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,11-17 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in reference to communication received 27 May 2008. Claims 1, 3, 11 – 17 and 19 – 25 are pending for examination.

### ***Response to Arguments***

Applicant's arguments and concerns are for amended claims which have been responded to in response to the pending amended claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 11 – 17 and 19 – 25 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites the limitation “receiving, at the virtual market place, a request for a price quote for the one or more commercial real estate service providers matched in the preceding step”. As currently claimed, it is not clear whether the claimed invention is directed to receiving price quote for the one or more commercial real estate service providers, or, it is directed to receiving price quote from the one or more commercial real estate service providers.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 11 – 17 and 19 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,842,178.

Regarding claims 1, 12 and 20 Giovannoli teaches computer implemented system and method for obtaining a product or service. Giovannoli does not explicitly recite obtaining product or service in support of commercial real estate transactions. However, one of ordinary skill in the art could have modified Giovannoli by offering products and services related to commercial real estate to provide a centralized procurement system for commercial real estate related services.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Giovannoli by applying a known technique to a known device or method ready for improvement to yield predictable result.

Giovannoli teaches capability for:

providing a virtual marketplace to market services of a plurality of commercial real estate service providers [Giovannoli, Fig. 2a and disclosure associated with the Figure];

receiving at the virtual marketplace, a request for information regarding a requested commercial real estate service available from the commercial real estate service providers, wherein the request comprises request criteria defining the requested commercial real estate service [Giovannoli, Fig. 2a and disclosure associated with the Figure] wherein requested service can be for a specific property;

receiving and storing service provider criteria from each of the service providers, the service provider criteria defining services provided by each respective service provider (obvious to one of ordinary skill in the art that Giovannoli has access to such stored information to be able to identify vendors who can fulfill customer requests) [Fig. 4 and disclosure associated with the Figure];

matching the request criteria with the service provider criteria of one of the service providers to identify a specific service provider that can provide the requested service [Fig. 5 and disclosure associated with the Figure];

publishing at the virtual marketplace information responsive to the request based on matching the request criteria identifying the property and defining the requested commercial real estate service with one or more commercial real estate service providers, wherein the information responsive to the request is published as one of textual information regarding the commercial real estate service providers and links to web sites of the commercial real estate service providers [Giovannoli, Fig. 2a and disclosure associated with the Figure];

receiving, at the virtual market place, a request for a price quote for the one or more commercial real estate service providers matched in the preceding step; and

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sending the request for a price quote to the one or more commercial real estate service providers [Giovannoli, Fig. 2a and disclosure associated with the Figure].

Regarding claim 3, Giovannoli teaches capability for:

receiving and storing service provider criteria from each of the service providers, the service provider criteria defining services provided by each respective service provider (obvious to one of ordinary skill in the art that Giovannoli uses such information to be able to identify vendors who can fulfill customer requests) [Fig. 4 and disclosure associated with the Figure].

matching the request criteria identifying the property and defining the requested commercial real estate service with the stored service provider criteria to identify one or more service providers that can provide the requested service (it is old and known business practice to identify local service providers to save on travel costs, identify licensed service providers) [Fig. 5 and disclosure associated with the Figure].

wherein the information published is information corresponding to the identified one or more service providers.

Regarding claim 11, The method of claim 1, wherein the services comprise services and products.

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Regarding claim 13, Giovannoli teaches capability wherein the due diligence services comprise at least one of an engineering service, an environmental service, or an appraisal service.

Regarding claim 14, Giovannoli teaches capability wherein the engineering service comprises at least one of a property condition report, an Americans with Disabilities Act compliance review, 'a building forensic study, construction monitoring, design/build construction, detailed design engineering, engineering desktop review, estimating, a feasibility study, a physical needs assessment, process engineering, reserve analysis, and a seismic study report.

Regarding claim 15, Giovannoli teaches capability wherein the environmental service comprises at least one of a Phase I, Phase II, or Phase III environmental assessment.

Regarding claim 16, Giovannoli teaches capability wherein the Phase I environmental service comprises a protocol environmental assessment,

wherein the Phase II environmental service comprises at least one of asbestos assessment, lead-based paint assessment, underground storage tank management, a ground water survey, and an operation and maintenance program, and

wherein the Phase III environmental service comprises at least one of an asbestos screening, a lead-based paint screening, a transaction screening, governmental records searching and interpretation, and a report review and opinion.

Regarding claim 17, Giovannoli teaches capability wherein the appraisal service comprises at least one of a property valuation report, an ad valorem tax appraisal, a feasibility study, a financial reporting valuation, a highest and best use analysis, an impact analysis, insurance placement, and an insurance replacement cost study.

Regarding claim 19, Giovannoli teaches capability wherein the services comprise services and products.

Regarding claim 21, Giovannoli teaches capability wherein the request criteria identifying a specific property comprises at least one of a property address, a building size, a site size, an age of the building, a property type, and a number of buildings on site.

Regarding claim 22, Giovannoli teaches capability wherein the at least one requested commercial real estate service of the request criteria comprises at least one of an engineering service, an environmental service, or an appraisal service.



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Regarding claim 23, Giovannoli teaches capability wherein the engineering service comprises at least one of a property condition report, an Americans with Disabilities Act compliance review, a building forensic study, construction monitoring, design/build construction, detailed design engineering, engineering desktop review, estimating, a feasibility study, a physical needs assessment, process engineering, reserve analysis, and a seismic study report.

Regarding claim 24, Giovannoli teaches capability wherein the environmental service comprises at least one of a Phase I environmental service comprising a protocol environmental assessment, a Phase II environmental service comprising at least one of asbestos assessment, lead-based paint assessment, underground storage tank management, a ground water survey, and an operation and maintenance program, and a Phase III environmental service comprising at least one of an asbestos screening, a lead-based paint screening, a transaction screening, governmental records searching and interpretation, and a report review and opinion.

Regarding claim 25, Giovannoli teaches capability wherein the appraisal service comprises at least one of a property valuation report, an ad valorem (according to the value) tax appraisal, a feasibility study, a financial reporting valuation, a highest and best use analysis, an impact analysis, insurance placement, and an insurance replacement cost study.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Solomon US Patent 7,302,404
2. Rudnick US Patent 7,295,989
3. Sheth et al. US Patent 7,069,242
4. Spencer US Patent 6,356,909

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 18, 2008

/Naresh Vig/  
Primary Examiner, Art Unit 3629